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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,427	04/19/2001	Yutaka Matsuda	AOKI - 1	3582
26345	7590	09/12/2005	EXAMINER	
GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE 1 RIVERFRONT PLAZA NEWARK, NJ 07102-5497			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/838,427

Applicant(s)

MATSUDA ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 19 April 2001. Claims 1-19 are pending. An IDS statement has not entered or considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The claim fails to recite any system elements. It presently recites "wherein a guaranty provider...", "wherein a guarantee...", and "wherein a guarantor...." It does not appear that the recitation of these wherein clauses constitutes system elements or components. Claims 2-10 inherit the deficiencies of claim 1, and are therefore rejected for the same reasons. For purposes of applying prior art, the Examiner interprets claim 1 to comprise a system having a guaranty provider providing a guarantee.
4. Claims 11-19 provide for the use of a guaranty which guarantees that an amount of an industrial emission generated from a preset industrial business fulfills a preset requirement, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass.

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A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. For purposes of applying prior art, the Examiner interprets claim 11 to be a transaction of a guaranty.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claim 1 only recites an abstract idea. The recited elements do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention does not appear to have a concrete result. In particular, it is unclear whether a system as recited in claims 1-10 can be repeatable and predictable (and thus, concrete), since it appears that the guaranty is subject to human interaction and not a function of the claimed invention. Simply stated, when a human opts not to give a guaranty, what concrete result is obtained by the invention?

Thus, because claim 1 fails the requirement for being within the technological arts, and providing a concrete result, claim 1 is deemed to be directed to non-statutory subject matter.

(B) Similar analysis can be applied to independent claims 2-10. Therefore those claims are rejected for the same reasons as claim 1.

7. Claims 11-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 11-19 appear to be directed toward a transaction. However, it is unclear as to which recognized statutory class of invention the transaction of claim 11 is directed. In particular, a transaction is not a process or method as it lacks a series of steps. A transaction is not a machine or system as there is no specific recitation of machine or system components. A transaction is not recognized as a composition of matter. A transaction of a guaranty, per se, is merely a collection of the financial, legal, or administrative rights and obligations of the parties involved. Since these rights and obligations are typically fixed in some tangible medium, a possible category for a "transaction" may be "article of manufacture."

Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). The claims, as presently recited, do not appear to have a concrete result. In particular, it is unclear whether a transaction of a guaranty which guarantees an amount of an industrial emission generated from a preset industrial business fulfills a preset requirement as recited in claim 11 can be repeatable and predictable (and thus, concrete), since it appears that the guaranteeing by the guaranty is subject to human interaction and not a function of the claimed invention. Simply stated, when a human opts not guarantee the plan, what concrete result is achieved by the invention?

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Further, the transaction as recited in claim 11 (as an apparent "article of manufacture") fails to have a tangible and concrete result. Claim 11 merely recites non-functional descriptive material, as no recitation of executable code or a data structure is provided. Further, the transaction is not explicitly recited as being embodied on any medium. Thus, the transaction of claim 11 is not tangibly embodied since it is drawn to the financial, legal, or administrative rights and obligations per se. And as noted above, it is unclear whether a "a transaction" can be repeatable and predictable (and thus, concrete), since it appears that the guaranteeing of the transaction is subject to human interaction and not a function of the claimed invention.

In light of the above, it is respectfully submitted that the claimed invention, although useful, does not have a tangible and concrete result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

(B) Similar analysis can be applied to independent claims 12-19. Therefore those claims are rejected for the same reasons as claim 11.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 7-9, 11, 13, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Applicant's Background of the Invention (pg. 1 of the specification).

(A) As per claim 1 and 11, Applicant's Background of the Invention discloses a system for providing a guaranty which guarantees that an amount of an industrial mission generated from a preset industrial business fulfills a preset requirement (pg. 1, lines 9-16 and lines 20-26), wherein a user or manufacturer obtains the guaranty through a contract (pg. 1 lines 9-29), wherein the contract provider provides the user or manufacturer with the hardware required to carry out the industrial business without any charge for the hardware (pg. 1 lines 17-27).

(B) As per claims 2 and 13, Applicant's Background of the Invention discloses the hardware being a plant (pg. 1 lines 10-11).

(C) As per claims 7 and 18, Applicant's Background of the Invention discloses the industrial omission being waste (pg. 1 lines 9-16).

(D) As per claim 8 and 19, Applicant's Background of the Invention discloses the preset requirement being defined by an Official Requirement against an industrial omission (pg. 1 lines 21-26).



***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-4 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pg. 1 of the specification) in view of Business Line (Business Line: India: Siam Plans to offer emission warranty for all vehicles, Feb. 21, 2001).

(A) As per claims 3-4 and 14-15, the Applicant's Background of the Invention does not expressly disclose the guarantor conducting maintenance of the hardware or operation of the hardware. Business Line discloses maintenance of hardware and operation of the hardware (pg. 1, par. 1-6). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Business Line within Applicant's Background of the Invention with the motivation of providing better emission monitoring (Business Line, pg. 1, par. 1).

12. Claims 5-6, 9-10, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pg. 1 of the specification).

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(A) As per claims 5-6 and 16-17, Applicant's Background of the invention does not disclose obtaining the guaranty from the provider through a transaction of a purchase and sale or lease guaranty. However, the Examiner respectfully submits that it is well known in the art to use both a purchase and sale or lease guaranty in obtaining hardware. For example, not Applicant's discussion at pg. 1 lines 25-26 of the specification "a contract for obtaining hardware." It is respectfully submitted that this contract for hardware would be either a lease or purchase and sale. The motivation being to provide different financing options for a manufacturer.

(B) As per claims 9-10, Applicant's Background of the invention does not disclose the provider and guarantor being identical to each other or different from each other. The Examiner respectfully submits that the courts have broadly held that the rearrangement of parts is obvious. Thus, it would be obvious to rearrange the provider and guarantor to allow them to be identical or different. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). The motivation being to provide for different means of guaranteeing the industrial omissions and hardware.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches system and method for determining risk exposure based on adjacency analysis (6,301,563), nuclear decommission insurance financial product and method (6,772,128), taking care of lizzie

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(Baldo), and system and method for developing and/or maintaining a workplace respiratory protection program (5,893,070).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

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**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]


(571) 273-6767 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

*CB*

CB

September 6, 2005

  
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